

# Notice of Allowability

## Application No.

08/785,455

## Examiner

Kathleen M Kerr

## Applicant(s)

HODGSON ET AL.

## Art Unit

1652

### -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 9/2/04.
2. ☒ The allowed claim(s) is/are 46,47,50-52 and 56-58.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All b) ☐ Some\* c) ☐ None of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

### THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

  
Kathleen M Kerr  
Primary Examiner  
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## **DETAILED ACTION**

### ***Application Status***

1. In response to the previous Office action, an abandonment (mailed on July 28, 2004), Applicants filed a petition to revive and an amendment received on September 2, 2004. Said petition has been granted; see paper mailed November 2, 2004. Said amendment cancelled Claims 26, 49, 53, 54, and 59-91. Thus, Claims 46, 47, 50-52, and 56-58 are pending in the instant Office action and will be examined herein.

### ***Priority***

2. As previously noted, the instant application is granted the benefit of priority for the foreign applications 9601095.4 and 9615845.6 filed in the United Kingdom on January 19, 1996 and July 27, 1996, respectively. The Examiner notes that the full-length methionyl tRNA synthetase sequence is disclosed in the latter foreign application; thus, the pending claims are afforded an earliest effective filing date of July 27, 1996.

### ***Information Disclosure Statement***

3. The information disclosure statement filed on February 2, 1998 has been previously considered as noted in Paper No. 9.

### ***Withdrawn - Objections to the Specification***

4. Previous objection to the specification because the title is not descriptive is withdrawn by virtue of Applicant's amendment.

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5. Previous objection to the specification for not having a complete Abstract is withdrawn by virtue of Applicant's amendment to the Abstract.

6. Previous objection to the specification for having inconsistent citations is withdrawn by virtue of Applicant's amendment.

***Withdrawn - Objections to the Claims***

7. Previous objection of Claim 65 as a duplicate claim of Claim 50 or 52 is withdrawn by virtue of Applicant's cancellation of said claim.

8. Previous objection of Claims 65-69 for depending from a rejected claim is withdrawn by virtue of Applicant's cancellation of said claims.

***Withdrawn - Claim Rejections - 35 U.S.C. § 112***

9. Previous rejection of Claims 26, 49, 53, and 54 under 35 U.S.C. § 112, second paragraph, as being indefinite for the term "about" is withdrawn by virtue of Applicant's cancellation of said claims.

10. Previous rejection of Claims 65-74 under 35 U.S.C. § 112, second paragraph, as being indefinite for the use of the transitional phrase "consists of" is withdrawn by virtue of Applicant's cancellation of said claims.

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11. Previous rejection of Claims 59 and 64 under 35 U.S.C. § 112, second paragraph, as being indefinite for the inclusion of the complementary sequence is withdrawn by virtue of Applicant's cancellation of said claims.

12. Previous rejection of Claims 26, 49, 53, 54, 60-64, and 70-91 under 35 U.S.C. § 112, first paragraph, written description, is withdrawn by virtue of Applicant's cancellation of said claims.

13. Previous rejection of Claims 26, 49, 53, 54, 60-64, and 70-91 under 35 U.S.C. § 112, first paragraph, scope of enablement, is withdrawn by virtue of Applicant's cancellation of said claims.

#### *Rejoinder*

14. Claims 46, 47, 50-52, and 56-58 are directed to an allowable product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), Claim 18, directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, is now subject to being rejoined. Thus, the restriction requirement made between polynucleotide, original Claims 1-12 and 26, and methods of use of said polynucleotides, Claim 18, is herein withdrawn.

Process claim 18 would be hereby rejoined and fully examined for patentability under 37 C.F.R. § 1.104 except that Claim 18 was cancelled by Applicant (see paper filed March 22, 2000). Applicant's representative, Darla Yoerg, was telephoned on December 21, 2004 and she formally declined reinstatement of the previously cancelled subject matter **only** for the purpose of advancing prosecution; said subject matter has not been disclaimed by Applicant.

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In accordance with the Official Gazette notice, *supra*, process Claims 17, 20-22, and 27, which do not depend from or otherwise include all the limitations of the allowable product, will NOT been rejoined.

***Other Art for the Record***

15. The Examiner notes the following:

- a) USPAP 20040029129 (Wang *et al.*) teach essential genes in various organisms, one of which is *S. aureus*. SEQ ID NO:2 of the instant application is encoded by SEQ ID NO:7749 of Wang *et al.*; however, Wang *et al.* is not prior art.
- b) USPNs 6,593,114 and 6,737,248 (Kunsch *et al.*) teach *S. aureus* sequences, in particular SEQ ID NO:98, which encodes a protein that is 99% identical to SEQ ID NO:2 of the instant application. Also disclosed in USPAP 20040043037.
- c) USPAP 20020061569 (Hasselbeck *et al.*) teach essential genes in various organisms, one of which is *S. aureus*. SEQ ID NO:2 of the instant application is almost exactly encoded by SEQ ID NO:8915 (one mismatch) of Hasselbeck *et al.* Hasselbeck *et al.* is not prior art.

***Conclusion***

16. Claims 46-47, 50-52, and 56-58 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Kerr whose telephone number is (571) 272-0931.

The examiner can normally be reached on Monday through Friday, from 9:00am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathupura Achutamurthy can be reached on (571) 272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kathleen M Kerr  
Primary Examiner  
Art Unit 1652

December 27, 2004